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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application

Frank AUSTRUP, et al.

Examiner: Stephen J. Rawlings

Application Number: 09/744,866

Group Art Unit: 1643

Filed: April 2, 2001

Confirmation No.: 5636

Attny Dkt. No.: GIES3001/ESS

For: **CANCER CELLS FROM BODY FLUIDS CONTAINING CELLS,  
ISOLATION THEREOF AND AGENTS CONTAINING THE SAME**

**PETITION TO THE DIRECTOR PURSUANT TO 37 C.F.R. 1.181(a) REQUESTING ENTRY  
OF THE AMENDMENT UNDER 37 C.F.R. 1.312 WHICH HAS BEEN DISAPPROVED**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

An Amendment Under 37 C.F.R. 1.312 was filed on April 4, 2007 directed to addition of five new dependent claims, namely claims 29, 30, 31, 32 and 33.

By a paper dated May 14, the amendment was disapproved only because of an asserted defect in claim 31.

By this paper, the undersigned requests entry of the Amendment Under 37 C.F.R. 1.312 or if this is not approved, entry in part of claims 29, 30, 32 and 33.

ENTRY OF THE AMENDMENT

We turn now to claim 31 which the paper of May 14, 2007 finds fault with to disapprove the entire amendment.

Claims 24 (allowed) and 28 (allowed) and claims 30 and 31 are reproduced in an appendix hereto.

The May 14, 2007 paper finds fault with claim 31 on the basis that there is no antecedent basis in both claims 24 and 28 for the limitation "the body fluid or part thereof or resuspended (sic) cell containing fraction".

But claim 31 depends indirectly from both claims 24 and 28 and "body fluid or part thereof" is in claim 24 and "resuspended cell containing fraction" is in claim 28 and a normal reading of claim 31 would find that "body fluid or part thereof" in claim 31 refers only to claim 24 and "resuspended (sic) cell containing fraction" refers only to claim 28. Hence there is antecedent basis.

The file history suggests that this is the normal reading and that there is antecedent basis. Claim 5 in the reply of January 18, 2005 corresponds to claim 31 and depends indirectly from claims 1 and 3 in said reply which correspond to claims 24 and 28 (the only difference being a phrase found okay by the Board of Patent Appeals and Interferences) and the action of June 9, 2005 by the same examiner did not complain about no antecedent basis for claim 5.

The fact that resuspended is misspelled is submitted to be irrelevant. This is an obvious and apparent error which can be changed by certificate of correction.

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ENTRY IN PART

MPEP 714.16(e) requires entry in part of the Amendment Under 35 U.S.C. 1.312, namely of claims 29, 30, 32 and 33 which have not been asserted as defective. This section of the MPEP should be complied with.

No fee seems to be due for the paper but if a fee is due, charge it to Deposit Account No. 02-0200.

Respectfully submitted,  
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Date: May 17, 2007

## APPENDIX

Claims 24, 28, 30 and 31 are set forth below:

24. (Allowed on Appeal) A method for isolating disseminated tumor cells from a cell-containing body fluid, consisting essentially of passing a cell-containing body fluid or part thereof that comprises a disseminated tumor cell through a screen having a mesh or pore width of about 15 to 30  $\mu\text{m}$  to separate non-cancer cells from disseminated tumor cells, wherein the disseminated tumor cells are retained on the screen wherein the body fluid is selected from the group consisting of blood and bone marrow, wherein the disseminated tumor cells are not modified prior to screening by labeling, by attaching particles, by triggering aggregation, by triggering cluster formation, with antibodies, enzymes, lectins, other ligands, other receptors or cross linking agents or by fixing.

28. (Allowed on Appeal) A method for isolating disseminated tumor cells from a cell-containing body fluid, consisting essentially of separating cellular components from non-cellular components in a body fluid that comprises a disseminated tumor cell to obtain a cell-containing fraction; resuspending the cell-containing fraction in a suspension medium; and passing the resuspended cell-containing fraction through a screen having a mesh or pore width of about 15 to 30  $\mu\text{m}$  to separate non-cancer cells from disseminated tumor cells, wherein the disseminated tumor cells are retained on the screen, and wherein the body fluid is selected from the group

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consisting of blood and bone marrow, wherein the disseminated tumor cells are not modified prior to screening by labeling, by attaching particles, by triggering aggregation, by triggering cluster formation, with antibodies, enzymes, lectins, other ligands, other receptors or cross linking agents or by fixing.

30. (New) The method according to either claim 24 or 28, comprising removing from the screen the retained disseminated tumor cells.

31. (New) The method according to claim 30, wherein removing the retained disseminated tumor cells comprises passing a liquid through the screen in a direction opposite to that in which the body fluid or part thereof or resuspended cell-containing fraction is passed, to obtain a cell-containing wash liquid.